



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,470	08/06/2001	Edward J. Grenchus JR.	END920010061US1	1539

7590 11/13/2006

Shelley M Beckstrand  
Patent Attorney  
61 Glenmont Road  
Woodlawn, VA 24381-1341

EXAMINER
----------

LOFTIS, JOHNNA RONEE

ART UNIT	PAPER NUMBER
----------	--------------

3623

DATE MAILED: 11/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/923,470

Applicant(s)

GRENCUS ET AL.

Examiner

Johnna R. Loftis

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-15 and 19-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-15 and 19-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/30/06 has been entered.

***Response to Arguments***

2. Applicant's arguments filed 8/30/06 have been fully considered but they are not persuasive. Applicant has amended the claims to include the complexity factor representing processing time divided by volume. Examiner points out that it is not clear from the specification if this was the intended definition of complexity factor when the application was filed. In turning to the specification, the Applicant is deriving the complexity equation from a vague description of disassembly prototyping. As stated on pages 5 and 6 of the specification, the complexity factor is based on the difficulty of disassembly. There is mention of time on these pages, but time is only in reference to the time that must be taken to properly store the salvageable components, not to the time it takes to dismantle equipment. The claimed "equation" for complexity factor is not supported in the specification. All prior rejections under 35 USC 101 and 35 USC 112, 1<sup>st</sup> and 2<sup>nd</sup> paragraphs, are upheld. In addition new rejections under 35 USC 112 have been added.

Art Unit: 3623

3. In response to Applicants remarks regarding previous rejections under 35 USC 101, the remarks are not persuasive. Applicant states complexity is related to the time it takes to tear down a piece of equipment, but this is not supported in the specification. Previous rejections under 35 USC 101 are upheld.

4. In addition, Applicant states the determination of salvageable and disposable content is described in copending application 09/524,366, now Patent No. 7,054,824. Examiner asserts that the patent includes no explanation of how one of ordinary skill in the art determines what is salvageable or disposable.

5. Applicant's arguments with respect to previous rejections under 35 USC 112 have been considered but they are not persuasive based on above comments regarding the complexity factor. Previous rejections under 35 USC 112 have been upheld.

6. Previous rejections under 35 USC 112 of claims 16-18 have been withdrawn in response to the cancellation of these claims.

***Claim Rejections - 35 USC §101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

8. Claims 1, 3-15 and 19-32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. For a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the invention is not concrete since the claimed complexity factor is not fully described so that one of ordinary

Art Unit: 3623

skill in the art would know how to determine the complexity factor thereby leading to non-repeatable results in determining the complexity factor and staffing requirements. Since the invention is not concrete, the staffing requirements that are determined are not useful and are not tangible. Furthermore, in claim 8, the step of determining salvageable and disposable content is also not described in such a way that one skilled in the art would be able to make the determination. Specifically, there are no set guidelines for determining what characteristics make some material content salvageable and some material content disposable. As disclosed, the method of determining salvageable or disposable contents is completely subjective since depending on who is making the determination; the same part or item could be deemed as salvageable or disposable.

Since the recited process produces neither a useful, concrete, nor tangible result, claims 1, 3-15 and 19-32 are deemed non-statutory subject matter.

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 1, 3-15 and 19-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Art Unit: 3623

11. Specifically, the determination of the complexity factor is not described in such a way to enable one skilled in the art to make and/or use the invention. The only explanation of the complexity factor describes it as being determined by disassembly prototyping, which is completely subjective. The difficulty of disassembling material can be viewed differently depending on who or what is performing the disassembly. The complexity factor is subjective in that it is not fully described how one would disassemble or dismantle material and determine the complexity without some type of guidelines explaining what determines the level of complexity. Without fully understanding how to determine the complexity factor, one would also not be enabled to determine the staffing requirements.

12. Furthermore, the step of determining salvageable and disposable content is also not described in such a way to enable one skilled in the art to make/and or use the invention. Specifically, there are no set guidelines for determining what material content should be salvaged and what material content should be disposed of. As disclosed, the method of determining salvageable or disposable contents is completely subjective since depending on who is making the determination; the same part or item could be deemed as salvageable or disposable.

13. Also, the addition to the claims, wherein the complexity factor represents processing time divided by volume, is not supported by the specification. The Applicant is deriving the complexity equation from a vague description of disassembly prototyping. As stated on pages 5 and 6 of the specification, the complexity factor is based on the difficulty of disassembly. There is mention of time on these pages, but time is only in reference to the time that must be taken to properly store the salvageable components, not to the time it takes to dismantle equipment.

Art Unit: 3623

14. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

15. Claims 1, 3-15 and 19-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the determination of the complexity factor is unclear since there it is not fully disclosed how one of ordinary skill in the art would disassemble material and determine a complexity factor without some type of guidelines explaining what determines the level of complexity. The only explanation of the complexity factor describes it as being determined by disassembly prototyping, which is completely subjective. The difficulty of disassembling material can be viewed differently depending on who or what is performing the disassembly.

16. Also, the step of determining salvageable and disposable content is also not described in such a way to enable one skilled in the art to make/and or use the invention. Specifically, there are no set guidelines for determining what material content should be salvaged and what material content should be disposed of. As disclosed, the method of determining salvageable or disposable contents is completely subjective since depending on who is making the determination; the same part or item could be deemed as salvageable or disposable.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Johnna R. Loftis whose telephone number is 571-272-6736. The examiner can normally be reached on M-F 8am-4:30pm.

Art Unit: 3623

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 571-272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JL

11/6/06

  
TARIQ R. HAFIZ  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600